

REMARKS

These remarks are responsive to the Office Action dated December 20, 2002. Currently, claims 1-8 and 20-30 are pending in the application with claims 1, 20, 22, 23, and 30 being independent. Claims 8, 20-22, and 24-27 are amended. Claims 9-12 are cancelled without prejudice or disclaimer. Claims 29 and 30 are added. The support for claims 29 and 30 can be found in the specification on page 3, lines 2-11.

In the Office Action, dated December 20, 2002, the Examiner objected to the drawings under 37 C.F.R. § 1.83(a), as failing to show every feature of the invention specified in the claims. The Applicants corrected the drawings to accommodate Examiner's objection. Therefore, this objection is now moot.

In the Office Action, dated December 20, 2002, the Examiner objected to the specification under 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o), as failing to provide proper antecedent basis for the claimed subject matter. The Applicants entered appropriate correction to the claims to accommodate Examiner's objection. Therefore, this objection is now moot.

In the Office Action, dated December 20, 2002, the Examiner rejected claims 8 and 28 under 35 U.S.C. § 112, ¶ 1. Furthermore, the Examiner rejected claims 8, 20-24 and 27 under 35 U.S.C. § 112, ¶ 2. The Applicants amended claims 8, 20-24, and 27-28 to overcome Examiners rejections under 35 U.S.C. § 112, ¶ 1 and 2, respectively. Therefore, this rejection is now moot.

In the Office Action, dated December 20, 2002, the Examiner rejected claim 22 under 35 U.S.C. § 102(b) as being anticipated by Wang (hereinafter "Wang"). This rejection is respectfully traversed for at least the reasons set forth below.

In the Office Action, dated December 20, 2002, the Examiner rejected claims 20 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Wang. This rejection is respectfully traversed for at least the reasons set forth below.

In the Office Action, dated December 20, 2002, the Examiner rejected claims 23-24 under 35 U.S.C. § 103(a) as being unpatentable over Margolis (hereinafter "Margolis") in view of Eagan (hereinafter "Eagan"). This rejection is respectfully traversed for at least the reasons set forth below.

35 U.S.C. § 102(b)

In the Office Action, dated December 20, 2002, the Examiner rejected claim 22 under 35 U.S.C. § 102(b) as being anticipated by Wang. This rejection is respectfully traversed.

It is respectfully submitted that this rejection is improper. Under 37 C.F.R. § 1.104(c)(2), the Examiner:

...must cite the best references at his or her command... [when rejecting claims using a reference] the particular part [in the reference] relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Furthermore, under Manual of Patent Examining Procedure (hereinafter "MPEP") § 706, the Examiner must:

...clearly articulate any rejection ... in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.

It is respectfully submitted that the Examiner did not provide a proper rejection of claim 22 under 35 U.S.C. § 102(b) over Wang. Furthermore, if the Examiner is relying on this

reference to reject claim 22, the Examiner is obligated to properly identify this reference under MPEP 707.05(g) and 710.06. The Applicants respectfully submit that it is not at all clear to what the Examiner is referring to, when describing Wang in paragraph 8 of the Office Action, dated December 20, 2002. Therefore, because this rejection is improper under the aforementioned standards, the Examiner is respectfully requested to withdraw her rejection of claim 22.

However, if the Examiner is referring to U.S. Patent No. 5,669,702 to Wang *et al.* (hereinafter “’702 patent” and cited by the Applicants in the Information Disclosure Statement dated October 22, 2002), the Applicants respectfully submit that ‘702 patent does anticipate amended claim 22 of the present application. ‘702 patent does not describe “means coupled to said circuit means for preventing said circuit means from generating said desired effect until the inflatable apparatus is being inflated,” as shown in the amended claim 22.

Claim 22 is directed to an inflatable apparatus having a shell, a circuit coupled to the interior of the shell and a means capable of preventing operation of the inflatable apparatus until the apparatus is inflated. According to FIGS. 1-4 in the ‘702 patent, an inflatable object includes a wall 20, a circuit 70 and a cap 80, where cap 80 is movable between a conductive and non-conductive positions and deactivates light emitting elements 72. This is clearly different from the claims 22 means for preventing the circuit from generating the desired effect until the inflatable apparatus is being inflated. Therefore, if the Examiner is relying on the ‘702 patent to reject claim 22, the Applicants respectfully submit that this rejection is traversed and the Examiner is respectfully requested to reconsider and withdraw her rejection of claim 22.

Independent claim 30 is not anticipated by the ‘702 patent for at least the same reasons presented above with respect to claim 22.

35 U.S.C. § 103(a)

In the Office Action, dated December 20, 2002, the Examiner rejected claims 20 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Wang. This rejection is traversed.

This rejection of claims 20 and 21 is improper for at least the same reasons articulated above. The Examiner is respectfully requested to withdraw her rejection of claims 20 and 21.

However, if the Examiner is relying on the '702 patent identified above, the Applicants respectfully submit that the '702 patent does not teach or suggest elements of claims 20 and 21.

Assuming that the Examiner is relying on the '702 patent, in the December 20, 2002 Office Action, the Examiner states that '702 patent discloses all elements of claims 20 and 21 except the tab coupled between the shell and the circuit.

Applicants respectfully point out to the Examiner that the '702 patent also does not teach or suggest a switch configured to automatically change from an open circuit position to a closed circuit position as the inflatable apparatus is inflated, as shown in the amended claim 20.

Amended claim 20 of the present Application is directed to an inflatable apparatus having a shell and a circuit coupled to an interior portion of the shell, where the circuit includes an energy source and a switch configured to automatically change from an open circuit position to a closed circuit position as the inflatable apparatus is inflated. The '702 patent describes an inflatable apparatus having a cap 80 that is movable between a conductive and non-conductive positions and deactivates light emitting elements 72, as mentioned above. However, '702 patent fails to teach or suggest a switch that automatically changes positions as the inflatable apparatus is inflated. According to the Examiner, "a person can move the tab[cap] from the non-conducting to a conducting position in order to change switch position." However, the switch in

the present invention automatically changes the switch position as the inflatable device is inflated. Therefore, the cap in '702 patent cannot be configured to automatically change from an open circuit position to a closed circuit position as the inflatable apparatus is inflated.

Amended claim 21 is dependent on the independent claim 20. As such, the '702 patent does not teach or suggest elements of claim 21 for at least the same reasons presented above with respect to amended claim 20. Therefore, this rejection, if based on the '702 patent, is respectfully traversed. If the Examiner is basing her rejection on the '702 patent, then the Examiner is respectfully requested to reconsider and withdraw her rejection of claim 21.

Furthermore, because the switch is configured to automatically change positions as the inflatable device is inflated, such function of the switch cannot be achieved through routine experimentation, as suggested by the Examiner in the December 20, 2002 Office Action. The court in In re Japikse referred to the "start of the pressing operation of ... hydraulic press" and not to the automatic change of position while another operation is performed, 86 USPQ 70 (CCPA 1950). Therefore, citation of In re Japikse is improper.

If the Examiner is not basing her rejection of claims 20 and 21 on the '702 patent, then the Examiner is respectfully requested to withdraw her rejection as moot.

In the Office Action, dated December 20, 2002, the Examiner rejected claims 23-24 under 35 U.S.C. § 103(a) as being unpatentable over Margolis in view of Eagan. This rejection is hereby respectfully traversed.

It is respectfully submitted that the Examiner did not provide a proper rejection of claims 23-24 under 35 U.S.C. § 103(a) over Margolis in view of Eagan. Furthermore, if the Examiner is relying on these references to reject claims 23-24, the Examiner is obligated to properly identify

the references under MPEP 707.05(g) and 710.06. The Applicants respectfully submit that it is not at all clear to what the Examiner is referring to, when describing combination of Margolis and Eagan in paragraph 12 of the Office Action, dated December 20, 2002. Furthermore, it is also not clear as to what the Examiner is referring on page 6, paragraph 12, line 20 of the Office Action, dated December 20, 2002, when the Examiner is citing "Wang's apparatus." Therefore, because this rejection is improper under the aforementioned standards, the Examiner is respectfully requested to withdraw her rejection of claims 23-24.

However, if the Examiner is referring to the combination of U.S. Patent No. 5,108,338 to Margolis (hereinafter "'338 patent" and cited by the Applicants in the Information Disclosure Statement dated October 22, 2002) and U.S. Patent No. 5,254,007 to Eagan (hereinafter "'007" patent and cited by the Examiner in the "Notice of References Cited," dated December 20, 2002), the Applicants respectfully submit that the combination of the '338 and '007 patents does teach or suggest amended claims 23-24 of the present application. Furthermore, if by "Wang's apparatus" the Examiner is referring to the apparatus described in the '702 patent, then the Examiner's attention is directed to the arguments presented above.

In December 20, 2002 Office Action, the Examiner stated that '338 patent discloses all of the elements of these claims except plurality of batteries, piezoelectric noise generator and a sound producing circuit being mechanically coupled to the interior of one of the plurality of sheets.

Applicants respectfully point out to the Examiner that '338 patent also does not teach or suggest a tab coupled to the switch and configured to change the switch from the open circuit position to the closed circuit position, as recited in claim 23.

Claim 23 is directed to a Mylar balloon having a sound producing circuit with an electric switch that is coupled to a tab that is configured to change the switch's position from the open circuit position to the closed circuit position. The '338 patent, however, describes a musical balloon having an electronic music producing device activated by a mechanical switch that is operated by pushing a button. A patch covers the mechanical switch and indicates where the button is located on the musical balloon. (See, Col. 2, line. 43-56). The '338 patent fails to teach or suggest the tab coupled to the switch and configured to change switch's circuit position from open to closed. The '338 patent musical balloon could not be used for an inflatable Mylar balloon, as described by claim 23.

The '007 patent describes a baby entertainment and learning apparatus for highchairs, but fails to disclose an inflatable Mylar balloon having a plurality of sheets having an edge and an interior side, where the sheets are coupled together at the edges, a circuit that is mechanically coupled to the interior side to one of the plurality of sheets, and a switch having a tab that is configured to change the switch from an open circuit position to a closed circuit position. The user of the baby entertainment and learning apparatus for highchairs activates a desired sound by applying a finger touch pressure to a particular picture disposed on a tray of the high chair and associated with the desired sound. (See, Col. 3, line 60 to Col 4, line 58). However, the '007 does not have a tab configured to change the switch's circuit position from open to closed, as recited in claim 23. Accordingly, neither '338 patent nor '007 patent teach or suggest every element of claim 23.

Improper To Combine.

There is no suggestion or motivation to combine the teachings of the '338 patent and the '007 patent. This is evidenced by the fact that '338 patent is directed to an inflatable musical balloon having an electronic music producing device that is manually activated by the user. The '007 patent is directed to an entertainment and learning apparatus for highchairs having a removable tray, which includes images and corresponding buttons that upon being pressed generate a sound. The inflatable musical balloon described by the '338 patent is inapplicable to the musical highchair described by the '007 patent, as the musical highchair in the '007 patent does not inflate. Thus, one skilled in the art, facing the problems that the Applicants faced would not combine these references as the Examiner suggests.

Even If Combined Present Invention Nor Realized.

Even if one improperly combined the '338 patent and the '007 patent, the invention of claim 23 is not realized. Specifically, the '338 patent discloses a musical balloon having an electronic music producing device activated by a mechanical switch that is operated by pushing a button. Whereas, the '007 patent describes an entertainment and learning apparatus for highchairs having a removable tray, which includes images and corresponding buttons that upon being pressed generate a sound. Therefore, the combination of the '338 patent and the '007 patent would produce an inflatable entertainment and learning apparatus for high chairs capable of generating a sound. However, the combination fails to teach or suggest a Mylar balloon having a tab that is coupled to a switch and configured to change the switch's circuit position in a Mylar balloon.

The combination of '338 and '007 patents does not support a prima facie case of obviousness as suggested by the Examiner. Therefore, if the Examiner is relying on these particular patents, then the Examiner's rejection of claim 23 is respectfully traversed. The Examiner is respectfully requested to reconsider and withdraw her rejection of claim 23, if it is based on the combination of '338 and '007 patents. Otherwise, the Examiner is respectfully requested to withdraw her rejection of claim 23.

Amended claims 24-28 are dependent on the independent claim 23. As such, the combination of the '338 and '007 patents does not teach or suggest elements of claims 24-28 for at least the same reasons presented above with respect to claim 23. Therefore, this rejection, if based on the combination of the '338 and '007 patents, is respectfully traversed. If the Examiner is basing her rejection on the combination of '338 and '007 patents, then the Examiner is respectfully requested to reconsider and withdraw her rejection of claim 24 and objection to claims 25-28.

Furthermore, reference to In re Japikse is improper for at least the same reasons set forth above.

Independent claim 30 is patentable over the combination of '338 and '007 patents for at least the same reasons presented above with respect to claims 23-28.

35 U.S.C. § 112

In the Office Action, dated December 20, 2002, the Examiner rejected claims 8 and 28 under 35 U.S.C. § 112, ¶ 1. The Applicants have amended claims 8 and 28 to accommodate

Examiner's rejection. Therefore, this rejection is now moot. The Examiner is respectfully requested to reconsider and withdraw her rejection of claims 8 and 28.

In the Office Action, dated December 20, 2002, the Examiner rejected claims 8, 20-24 and 27 under 35 U.S.C. § 112, ¶ 2. The Applicants have amended claims 8, 20-24 and 27 to accommodate Examiner's rejection. Therefore, this rejection is now moot. The Examiner is respectfully requested to reconsider and withdraw her rejection of claims 8, 20-24 and 27.

In the Office Action, dated December 20, 2002, the Examiner rejected claims 20, 24 and 27 under 35 U.S.C. § 112, ¶ 2 as being indefinite because it is not clear how the word "automatically" is intended to further limit the device. The support for this feature in the claim is found in the Specification on page 3, lines 12-15. This section fully describes the "automatically" feature and provides definiteness to the term and proper antecedent basis for the use of this term in claims 20, 24, and 27. Therefore, this rejection is now moot. The Examiner is respectfully requested to reconsider and withdraw her rejection of claims 20, 24 and 27.

Terminal Disclaimer.

The Applicants respectfully submit a terminal disclaimer to obviate a double patenting rejection of obviousness type that the Examiner issued in the December 20, 2002 Office Action with respect to claims 1-4 and 20-24 over claims 1 and 2 of U.S. Patent No. 6,482,065 to Blackman. Therefore, the Examiner is respectfully requested to reconsider and withdraw her rejection of claims 1-4 and 20-24.

Objections

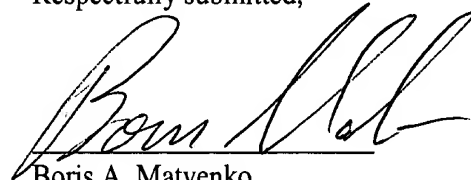
In the Office Action, dated December 20, 2002, the Examiner objected to the drawings under 37 C.F.R. § 1.83(a). The Applicants amended FIGS. 1, 3, and 4 to accommodate Examiner's objections. Therefore, this objection is now moot. The Examiner is respectfully requested to withdraw her objection of the drawings.

In the Office Action, dated December 20, 2002, the Examiner objected to the specification under 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o). The Applicants amended claim 8 and cancelled claims 9-12 to accommodate Examiner's objections. Therefore, this objection is now moot. The Examiner is respectfully requested to withdraw her objection of the drawings.

No new matter has been added.

The claims currently presented are proper and definite. Allowance is accordingly in order and respectfully requested. However, should the Examiner deem that further clarification of the record is in order, we invite a telephone call to the Applicants' undersigned attorney to expedite further processing of the application to allowance.

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims

Please cancel claims 9-12 without prejudice or disclaimer.

Please add the claims 29-30.

Please substitute the following claims for the currently pending claims:

8. (Amended) The apparatus according to Claim 1 wherein:

[said tab further including another distal portion wherein]said [another]distal portion of
said tab is coupled to said interior surface[; and,

wherein said tab is further arranged to move relative to said switch and to change said
position of said switch from said closed position to said open position upon deflation of said
inflatable device].

20. (Amended) An inflatable apparatus comprising:

a shell having an interior portion;

a circuit coupled to said interior portion;

said circuit including:

an energy source; and,

a switch electrically coupled to said energy source;

wherein said switch has an open circuit position and a closed circuit position; and,

wherein said switch is configured to automatically change from said open circuit position
to said closed circuit position as [said]the inflatable apparatus is inflated.

21. (Amended) The inflatable apparatus according to Claim 20 further comprising:
a tab coupled between said shell and said circuit;
wherein said tab is arranged to change said switch position from said open circuit position to said closed circuit position as [said]the inflatable apparatus is inflated.

22. (Amended) An inflatable apparatus comprising:
a shell having an interior portion;
circuit means for generating a desired effect coupled to said interior portion; and,
means coupled to said circuit means for preventing said circuit means from generating said desired effect until [said]the inflatable device is being inflated.

24.(Amended) The Mylar balloon according to Claim 23 wherein:
said tab is further coupled to said interior side of one of said plurality of sheets and is arranged to automatically change said switch from said open circuit position to said closed circuit position as [said]the Mylar balloon is inflated.

25.(Amended) The Mylar balloon according to Claim 23 wherein:
said tab comprises a valve configured to allow air into [said]the Mylar balloon.

26.(Amended) The Mylar balloon according to Claim 23 further comprising a valve coupled between said plurality of sheets and configured to allow air into [said]the Mylar balloon.

27.(Amended) The Mylar balloon according to Claim 26 wherein:

said tab is further coupled to said valve and is arranged to automatically change said switch from said open circuit position to said closed circuit position as [said]the Mylar balloon is inflated.

In the Figures

Please amend FIGS 1, 3, and 4 as indicated.

